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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,916	07/17/2007	Takafumi Kurosawa	TOS-167-USA-PCT	2935
27955	7590	10/24/2011	EXAMINER	
TOWNSEND & BANTA Suite 900, South Building 601 Pennsylvania Ave., N.W. Washington, DC 20004			KASSA, TIGABU	
			ART UNIT	PAPER NUMBER
			1619	
			NOTIFICATION DATE	DELIVERY MODE
			10/24/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/588,916	<b>Applicant(s)</b> KUROSAWA ET AL.
	<b>Examiner</b> TIGABU KASSA	<b>Art Unit</b> 1619

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 01 September 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1, 4, and 17.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

/CHERIE M WOODWARD/  
 Primary Examiner, Art Unit 1647

Continuation of 11: Applicant's remarks/arguments do not place the case in condition for allowance or in better condition for appeal.

Claims 1, 4, and 17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrari et al., (US 2003/0068348, published on 04/10/03), Tanaka (JP 2001-302455, machine translated, published on 10/31/2001, IDS reference), Masuda et al., (WO 02/26198, published on April 4, 2002), Yoneyama et al., (US Patent No. 5362482, published on November 8, 1994), and Simon (US Patent No. 6346256 published on February 12, 2002), for the reasons of record and the reasons set forth herein.

#### Response to Arguments:

Applicant argues that it is apparent that the instant rejection is a classic multi-reference hindsight rejection, which by law is overcomeable via presentation of secondary considerations, such as unexpected results. It is respectfully submitted that such unexpected results are clearly presented in the instant Specification.

These assertions are not found persuasive because in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Furthermore, in response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). The examiner is aware of the fact that secondary considerations such as unexpected results can be useful to overcome a rejection set forth under 35 U.S.C. 103. However, in the instant case the alleged result in the specification is not truly unexpected.

Applicant is arguing that the present inventors found that adding a (d) lipophilic active material to the sunscreen cosmetic of the present invention results in a water-in-oil emulsified sunscreen cosmetic that spreads easily, and has a fresh sensation when applied to the skin, consideration not found in any of the 5 cited references. In addition, it was unexpectedly discovered that by combining (a) the claimed hydrophobic zinc oxide powder (b) a volatile silicone, (c) 1-10 wt% caprylylmethicone, and (d) 0.5-4 wt% of a polyoxyalkylene-modified organopolysiloxane, as illustrated by the test results shown in Table 3, it is possible to obtain a sunscreen cosmetic that has a long lasting coverage effect and excellent ease of washability, and thus they arrived at the present invention. In contrast, as illustrated in Table 3, Comparative Example 1, which does not include the claimed caprylylmethicone, had a noticeably lower ease of washability (see Specification, page 41, line 7, to page 42, line 2).

The above assertions are not found persuasive because applicant relying upon comparative showing to rebut prima facie case must compare his claimed invention with closest prior art *In re Holladay*, 584 F.2d 384, 199 USPQ 516 (CCPA 1978); *Ex parte Humber*, 217 USPQ 265 (Bd. App. 1961). To the minimum applicant should compare their results with the composition of Ferrari et al. Ferrari et al., teach cosmetic composition, comprising liquid lipid phase containing silicone oil, structured by a combination of polymeric gelling agent and hydrophobic particles (see abstract). Ferrari et al. teach that the solid particles used in the compositions may be fillers or pigments (paragraph 0027). These fillers or pigments may be either hydrophobic or hydrophilic, on condition that they comprise, for example, a hydrophobic outer surface obtained, for example, by coating in a hydrophobic compound forming a hydrophobic film on their surface (paragraph 0033). When the pigments or fillers are hydrophilic, for example pigments such as zinc oxides, iron oxides and titanium oxides, they are coated with a film of hydrophobic compound to introduce them into the liquid fatty phase of the composition of the invention, or they are subjected to a hydrophobic treatment (paragraph 0050). The coating may comprise a surface treatment of the particles (paragraph 0051). The coating or surface treatment may be a fluoro coating such as a perfluoroalkyl monoester or diester of phosphoric acid (acid or salt), a perfluoropolyether, a perfluorocarboxylic or perfluorosulphonic acid, or a perfluoroalkyl diethanolamine phosphate salt (paragraph 0052). The surface treatment may also be carried out using silicone derivatives, for example grafting with reactive silicones initially comprising hydrogenosilane groups, grafting with a diorganosilane such as dimethylchlorosilane or with an alkylalkoxysilane, grafting with a silane comprising a glycidoxypentyl group, coating with a polyglycerolated silicone, or coating with a silicone-grafted acrylic copolymer or silicone-grafted-polyacrylic (paragraph 0054). The liquid fatty phase for example comprises at least 40% and further for example at least 50% by weight of at least one silicone oil (paragraph 0058). The silicone oils that may be used in the invention may be volatile or non-volatile, linear or cyclic polydimethylsiloxanes (PDMSs), that are liquid at room temperature; polydimethylsiloxanes comprising alkyl, alkoxy or phenyl groups, that are pendent and/or at the end of a silicone chain, the groups each comprising from 2 to 24 carbon atoms; phenylsilicones, for instance phenyl trimethicones, phenyl dimethicones, phenyl trimethylsiloxydiphenylsiloxanes, diphenyl dimethicones, diphenyl methylphenyl trisiloxanes and 2-phenylethyl trimethylsiloxydisilicates (paragraph 0059). Applicant is alleging that the cause of the unexpected properties is due to the incorporation of caprylylmethicone in the instant composition. As described above Ferrari teaches that the silicone oils that may be used in the invention may be volatile or non-volatile, linear or cyclic polydimethylsiloxanes (PDMSs), that are liquid at room temperature; polydimethylsiloxanes comprising alkyl, alkoxy or phenyl groups, that are pendent and/or at the end of a silicone chain, the groups each comprising from 2 to 24 carbon atoms; phenylsilicones, for instance phenyl trimethicones, phenyl dimethicones, phenyl trimethylsiloxydiphenylsiloxanes, diphenyl dimethicones, diphenyl methylphenyl trisiloxanes and 2-phenylethyl trimethylsiloxydisilicates (paragraph 0059). These silicones are closely both structurally and functionally related compounds as the caprylylmethicone that they are expected to behave similar as the alleged caprylylmethicone absent evidence to the contrary.